

REMARKS

Claims 1 to 15 are now pending. In view of the foregoing amendments and following remarks, reconsideration of the present application is respectfully requested.

Claims 13 to 15 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In this regard, claim 13 has been amended to correct a typographical error, and is believed to be self-explanatory. Support for amended claim 13 can be found, for example, on page 5, lines 11 to 20, and Figure 4, of the Specification. It is therefore respectfully requested that the rejection of claims 13 to 15 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Claims 1, 4, 5, and 8 to 10 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,226,747 ("Larson").

Claim 1 relates to a device for preventing pirated copies of computer programs for use with a computer, the device including input and output devices for bidirectional data exchange with the computer, a first memory element containing a data file that is transferrable to the computer via the output device, and a second memory element into which data is writable by the input device, and further provides that the data file transferrable to the computer includes a key. In this regard, the present application provides, for example, the following:

[A] data file containing an electronic key is transferred from the device to the computer. The data file is then only on the computer. As an alternative, the data file may also be copied from the device to the computer and then erased on the device.

Hence, the present invention as claimed may be exemplified, for example, using a dongle, in which before delivery of the dongle, the dongle is programmed with a unique key. If the program is installed, the key is removed from the dongle and hidden on the target computer, and a unique identifier of the computer is written into the dongle. With the key now residing on the computer, the program is executable on the target computer without the need of the dongle being attached, and the dongle may not be used to install an additional instance of the program on another computer. Should it be required to install the program on a different computer, the unique identifier of the computer is verified and the hidden key on the computer is transmitted back from the computer to the dongle so that program is no longer executable on this computer and the dongle may be used to install the program on another computer.

The Larson reference, by contrast, relates to a method and device for limiting the number of installations of a computer software program using a read-only storage device, such as a compact disk (CD), which includes the computer software program to be copied to the computer, and an accompanying removable read/write storage memory device inserted into the computer during the installation procedure, such as a floppy disk, which contains information linking it with a particular CD, such as a software serial number or software version identifier. (See Larson, Abstract, col. 3, lines 42 to 50, and col. 8, lines 20 to 28). The floppy disk also includes further information stored in an archive information file after each installation of the software program that identifies each computer upon which the software program was installed (i.e., a “data fingerprint”). (See Larson, col. 8, lines 50 to 64).

In this regard, installation of the computer software program is authorized by verifying the link between the CD and the floppy disk and then comparing the identification information of the computer to the identification information previously stored on the floppy disk. (See Larson, col. 3, lines 53 to 57). If the identification information of the computer has not been previously stored on the floppy disk, and if the computer software program has not been installed in excess of the limits of the license as indicated by the number of computer for which identification information is stored in the archive information file of the floppy disk, the installation of the computer software program from the CD to the particular computer is allowed. (See Larson, col. 3, lines 57 to 62). If, on the other hand, the linked floppy disk is not present or the number of computers for which identification information stored in the archive information file reaches the predefined limit, the installation is disallowed. (See Larson, col. 3, lines 62 to 65).

In this regard, it is respectfully submitted that any data or data file resident on either the CD or the floppy disk regardless of its contents is never “transferred” to the computer in the manner contemplated by claim 1, such that the data file is then only on the computer, but instead is merely read so that the data or data file remains on the CD or floppy. Indeed, even the computer software program remains on the “read-only” CD after installation. Moreover, as admitted on page 3 of the Office Action, Larson does not disclose data including a key, or a first and second memory element arranged on a memory chip. Accordingly, for at least these reasons, it is respectfully submitted that Larson does not identically disclose or suggest, a data file that is transferable to a computer, which includes a

key, or a first and second memory element arranged on a memory chip, as recited in claim 1 — as it must to support an anticipation rejection.

It is also respectfully submitted that that col. 5, lines 4 to 8, of Larson, which were asserted on page 3 of the Office Action as disclosing certain features of claim 1, merely refer to the installation CD as linked to the floppy disk, which is not required by the present application. In particular, a more flexible approach involving an independent and simple production of the installation CD is possible with the present invention, since the license may be shifted each time only by a temporary adaptation of the dongle in combination with the key and computer identifier. For example, a demo CD may be provided without the need of a dongle or clearing or unlock code, and may be activated later on to a complete version, if desired. Moreover, since the presently claimed subject matter does not dictate that a test for a valid license be coupled to the installation routine, as required by Larson, a faster change of the license between more than one computer without the required previous deinstallation may be provided while at the same time preventing the bypass of the copy protection via manual copy of the program data.

It is still further respectfully submitted that col. 2, lines 11 to 30, of Larson do not support the Final Office Action's assertion that "the dongle is used to provide software key" but instead refer to the dongle as a "hardware key" having certain inherent drawbacks in which "the user was required to carry the dongle back and forth so that it could be physically attached to the computer before the software was used." Indeed, Larson explicitly states that "[w]ithout the dongle, the software cannot be used" — which teaches away from the approach advocated by the presently claimed subject matter. Hence, the text at col. 2, lines 11 to 30, demonstrate that Larson not only fails to disclose the features of the presently claimed subject matter, but in fact, teaches away from them.

It is therefore respectfully submitted that claim 1 as presented is allowable for at least these reasons.

Claims 4, 9 and 10 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Claims 5 and 8 as presented include features like those of claim 1, and are therefore allowable for essentially the same reasons as claim 1.

In sum, it is respectfully submitted that claims 1, 4, 5, and 8 to 10 are allowable for at least the reasons discussed above. Withdrawal of the anticipation rejections with respect to Larson is therefore respectfully requested.

As to paragraph 12 of the Final Office Action, to reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

With respect to the rejections of claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Larson in view of U.S. Patent No. 6,523,119 ("Pavlin"), it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Pavlin reference does not cure the critical deficiencies of the Larson reference (as explained above) with respect to claim 1, from which claims 2 and 3 ultimately depend. Indeed, the Office Action does not allege that Pavlin cures the deficiencies of Larson as applied against claim 1. It is therefore respectfully submitted that claims 2 and 3 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, withdrawal of the obviousness rejections of claims 2 and 3 is respectfully requested.

With respect to the rejection of claim 6 under 35 U.S.C. § 103(a) as unpatentable over Larson in view of U.S. Patent No. 6,434,535 ("Kupka") and further in view of U.S. Patent No. 6,411,941 ("Mullor"), it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Kupka and Mullor references do not cure the critical deficiencies of the Larson reference (as explained above) with respect to claim 5, from which claim 6 depends. Indeed, the Office Action does not allege that Kupka and Mullor cure the deficiencies of Larson as applied against claim 5. It is therefore respectfully submitted that claim 6 is allowable for at least the same reasons that claim 5 is allowable. Accordingly, withdrawal of the obviousness rejections of claim 6 is respectfully requested.

With respect to the rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over Larson, it is respectfully submitted that even if it were proper to modify Larson as suggested (which is not conceded), the proposed modification does not cure the

critical deficiencies of the Larson reference (as explained above) with respect to claim 5, from which claim 7 depends. Indeed, the Office Action does not allege that the proposed modification cures the deficiencies of Larson as applied against claim 5. It is therefore respectfully submitted that claim 7 is allowable for at least the same reasons that claim 5 is allowable. Accordingly, withdrawal of the obviousness rejections of claim 7 is respectfully requested.

Finally, as regards paragraph 15 of the Final Office Action and with respect to the rejections of claims 11 to 15 under 35 U.S.C. § 103(a) as unpatentable over Larson in view of U.S. Patent No. 5,109,413 ("Comerford"), it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Comerford reference does not cure the critical deficiencies of the Larson reference (as explained above) with respect to claim 1, from which claims 11 and 12 depend. Indeed, the Office Action does not allege that Comerford cures the deficiencies of Larson as applied against claim 1. It is therefore respectfully submitted that claims 11 and 12 are allowable for at least the same reasons that claim 1 is allowable.

Claim 13 recites features essentially analogous to claim 1, and is therefore allowable for at least the same reasons as claim 1.

Claims 14 and 15 depend from claim 13 and are therefore allowable for at least the same reasons as claims 13.

Accordingly, withdrawal of the obviousness rejections of claims 11 to 15 is respectfully requested.

As further regards the obviousness rejections of claims, to the extent that the Office maintains the unsupported "ordinary skill" statements regarding those rejections, it is respectfully requested pursuant to 37 C.F.R. § 1.104(d)(2) that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03). Otherwise, if the Office cannot provide either references or an affidavit to support the contentions now made, it is respectfully requested that the obviousness rejections of the claims be withdrawn for this reason alone.

In summary, it is respectfully submitted that all of claims 1 to 15 of the present application are allowable at least for the foregoing reasons.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn since they have been obviated. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
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